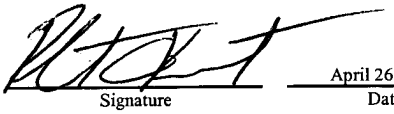
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/588,879 §
Filed: June 6, 2000 §
Inventors: §
Nobuyoshi Morimoto §
§
§
§
§
Title: System and Method for §
Identifying Individual Users §
Accessing a Web Site §
§
§
§
§

Examiner: England, David E.
Group/Art Unit: 2143
Atty. Dkt. No: 5596-00200

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Robert C. Kowert
Name of Registered Representative



Signature

April 26, 2006
Date

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants request review of the rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated below.

Claims 1-37 remain pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments directed to the independent claims are presented, and that additional arguments, e.g., directed to the subject matter of the dependent claims, will be presented if and when the case proceeds to Appeal.

The Examiner rejected claims 1-3, 5, 6, 8, 9, 11, 12, 14-16, 18-22, 24-26, 28-31, 33, 34, 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Shelton et al. (U.S. Patent 6,418,471) (hereinafter "Shelton") in view of Holden et al. (U.S. Patent 6,272,639) (hereinafter "Holden"), Ananda (U.S. Patent 5,638,513) and Eichstaedt et al. (U.S. Patent 6,666,230) (hereinafter "Eichstaedt"), and claims 4, 7, 10, 13, 17, 23, 27, 32 and 35 as being unpatentable over Shelton, Holden, Eichstaedt and Ananda as applied above, and in further view of Bodnar et al. (U.S. Patent 6,295,541) (hereinafter "Bodnar"). Applicants respectfully traverse these rejections for at least the reasons presented below. Appellants submit that the Examiner has clearly failed to present a *prima facie* rejection of Appellants' independent claims.

The cited art, whether considered singly or in the Examiner's combination, fails to teach or suggest Applicant's claimed invention. Applicant's invention as claimed involves identifying individual or distinct users accessing a web site by associated a unique identifier with each computer system requesting access to the web site. As recited in claim 1, the unique identifier includes an Internet address and a time value associated with the computer system requesting access to the web site. When a computer requests access to the web site, the

requesting computer is sent a request for an Internet address and a time value corresponding to the that computer. The computer requesting access is identified as a distinct user if no record matching the Internet address and time value exists in a database of such records. As shown below, the Examiner's combination of cited art fails to teach or suggest the unique combination of limitations of Applicant's claims.

The Examiner's proposed combination of Shelton, Holden, Ananda and Eichstaedt fails to teach or suggest determining whether a matching record for the first Internet address and the first time value exists in the database, and identifying the first computer as a distinct user if the matching record does not exist in the database, as recited in claim 1. The Examiner refers to col. 7, lines 23 – 63, of Eichstaedt in regard to these limitations of claim 1. Eichstaedt teaches a server implemented method that automatically recognizes when a client computer is making requests too frequently or is accessing too much of the server computer's resources (col. 3, lines 46 – 49). Thus, Eichstaedt teaches comparing *a number of requests made within a time period* to a predefined maximum number and does not teach or suggest determining if a time value contained in a matching record exists in a database, as recited in claim 1. Furthermore, Eichstaedt teaches performing a series of frequency checks if a client identifier is not found in a deny list, but does not teach or suggest identifying the first computer as a distinct user if the matching record does not exist in the database.

Additionally, there is no teaching or suggestion in any of the cited references, whether considered alone or in combination, of determining whether a matching record for the first Internet address and the first time value exists in the database, and identifying the first computer as a distinct user if the matching record does not exist in the database. The Examiner admits that Shelton fails to teach either determining a matching record or identifying a distinct user as recited in claim 1. Holden, not relied upon by the Examiner for these limitations, does not pertain at all to determining whether a matching record for an Internet address and a time value exists in a database to identifying a computer as a distinct user if such a record does not exist. In contrast, Holden teaches a system for multi-level security in a mixed enclave network. Ananda also fails to teach or suggest anything about identifying a distinct user if a record matching an Internet address and a time value does not exist in a database. Ananda is not concerned with identifying distinct users, but instead deals with ensuring that a rental application only executes while a user's computer is continuously connected to a central rental facility computer. Ananda fails to teach anything regarding identifying a computer as a distinct user dependant upon whether a record exists in a database matching an Internet address and a time value corresponding to the computer.

Furthermore, the respective teachings of Shelton, Holden, Ananda and Eichstaedt have nothing to do with each other or with Applicant's claimed invention. The Examiner is clearly attempting to reconstruct Applicant's claim in hindsight by piecing together unrelated teachings from the cited art. For example, Shelton's teaching pertain to recording and reproducing *client-side browser activity* whereas Holden's teachings pertain to secure communications within a mixed enclave network. Eichstaedt's teachings pertain to monitoring access frequency and/or total amount of data downloaded *at a server*, and Ananda's teachings pertain to allowing rented software to execute only while the user's computer is continually connected via modem to a central computer. Even if combined, the disparate systems of Shelton, Holden, Ananda and Eichstaedt would not result in Applicant's claimed invention.

For example, even if modified according to the teachings of Holden, Ananda and Eichstaedt, the system of Shelton would not include sending a request for information to a computer requesting to access a web site, where the information includes an Internet address and a time value corresponding to the computer. Shelton's system has no need for Holden's ARP request or Ananda's transfer time requests. Shelton teaches the use of various applets to send information from client computers to Shelton's WTS server (Shelton, column 5, lines 8-45). Shelton's system does not include the WTS server sending requests for information, such as the Internet address and time value of Applicant's claims, to client computers that are requesting access to a web site. Instead, Shelton teaches the use of applets executing on the client computer sending (not in response to a request) information regarding the client's browsing activities. Shelton's applets are responsible for initiating communication with Shelton's WTS server (Shelton, column 5, lines 59-55). The WTS mechanism of Shelton

does not request any information from terminals 104. Thus, even if the teachings of Holden were considered in combination with Shelton, it would not suggest that Shelton's server would request an Internet address from another computer because there are no such requests in Shelton. Shelton's system works in a completely different manner than Applicant's claimed invention. Likewise, even if the teachings of Ananda were considered in combination with Shelton, it would not suggest that Shelton's server would request a time value from another computer corresponding to that computer because there are no such requests in Shelton.

Similarly, Eichstaedt's teachings combined with Shelton would at most suggest recording browsing activities as taught by Shelton and identifying and preventing access by robots and web-crawlers as taught by Eichstaedt. The Examiner's combination of cited art simply does not result in Applicant's invention as claimed.

Moreover, the combination of references is not proper because the Examiner has not provided a proper motivation to modify Shelton in view of Holden, Ananda and Eichstaedt. The Examiner contends that it would have been obvious to modify Shelton to include the ARP messages of Holden "because if a system does not know a computer's address utilizing ARP to query a computer's address is well known in the art and would only take one of ordinary skill to implement". The Examiner's statement motivation amounts to nothing more than stating than saying that ARP messages are known and able to be implemented by one of ordinary skill in the art. However, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (underlining in the original, M.P.E.P. 2143.01, para. 9). The Examiner has not presented any arguments nor cited any portion of either Shelton or Holden that suggests any desirability of modifying Shelton to use the ARP messages of Holden. Shelton's system includes active components on the client systems for which Shelton is recording browsing activities, including keeping track of when each activity took place (Shelton, column 5, lines 9-45). Moreover, Shelton's applets are responsible for initiating communication with Shelton's WTS server (Shelton, column 5, lines 59-55). **Thus, there is no need, nor desirability, for Shelton's system to use the ARP messages of Holden.** Such a combination would simply not make sense in the context of Shelton's system. Furthermore, the Examiner's statement regarding how utilizing ARP to query a computer's address "is well known in the art and would only take one of ordinary skill to implement" does not provide a motivation to combine the references. All inventions include combinations of known elements.

In addition, there is absolutely no motivation to combine the teachings of Ananda with those of Shelton, Holden, and or Eichstaedt. The Examiner asserts that it would have been obvious to combine Ananda with Shelton and Holden "because updating a type of time stamp enables the system to keep track of users times on the network." This alleged reason to combine teachings of Ananda with those of Shelton and Holden is not supported in the teachings of the prior art and would not be a motivation to include Ananda's transfer time request in the systems of Shelton and Holden. Firstly of all, as noted above, Ananda's transfer time request is not sent by a central computer to keep track of a user's activity. Instead, it is requested by the user's computer to calculate a password. Secondly, Shelton's system already includes the capability to track and record a user's online activity (Shelton, column 2, lines 38-43; column 2, line 66 – column 3, line 11; and column 6, lines 7-23). No one with Shelton's teachings before them and desiring to keep track of users' times on a network would be motivated to implement Ananda's transfer time request.

In regard to Eichstaedt, the reason given by the Examiner to combine the references is that "it would be more efficient for a system to update and log users interactions with a web sites which could aid in the determination in trends or stop invalid users (robots) from accessing site that would require human interaction for payment of services." However, applying the method for automatically limiting access of a client computer to data objects taught by Eichstaedt to the web site in Shelton, as modified by Holden and Ananda, would only serve to filter out browser interactions from robots and prevent the determination of trends. Filtering out browser interactions would defeat the intended purpose of Shelton to record detailed browser activity to the web site. If a proposed modification would render the prior art feature unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Please refer to pages 20-22 of Appellant's Response to the Office Action of July 13, 2005 for a further detailed discussion regarding the lack of motivation to combine the respective teachings of Shelton, Holden and Eichstaedt.

As shown above, the Examiner's combination of cited art fails to teach or suggest the limitations of Applicants claim. Additionally, the Examiner has failed to provide a proper motivation to combine the cited art. Thus, the Examiner's rejection of claim 1 is clearly not supported by the prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 1 also apply in regard to independent claims 9, 12, 15, 16, 19, 20, 26, 29, 30, 34 and 37.

In addition, the Examiner has improperly ignored differences between various ones of Applicant's independent claims. For example, the Examiner rejects claim 12 for the same reasons as claim 1. However, claim 12 recites a client computer system operable to execute a program to synchronize time. **The Examiner has completely ignored this limitation of claim 12.** Neither Shelton, Holden, Ananda, or Eichstaedt, whether considered singly or in combination, teaches or suggests anything regarding a client computer system operable to execute a program to synchronize time. Thus, the Examiner has further failed to provide a *prima facie* rejection of claim 12.

In further regard to claim 16, Shelton in view of Holden, Ananda and Eichstaedt does not teach or suggest storing one or more identifiers, wherein each identifier comprises an Internet address and a time value; receiving a request from a first computer user to access the web site, wherein said requests comprises a first identifier corresponding to said first computer user accessing said web site. Additionally, Shelton in view of Holden, Ananda and Eichstaedt fails to teach or suggest searching for a matching identifier; and identifying the first identifier as a distinct computer user if said searching for said first identifier did not result in a match, as presented in claim 16. The Examiner rejects claim 16 for the same reasons as claim 1, discussed above. **The Examiner has improperly ignored differences between claims 1 and 16.** Nowhere does Shelton, Holden, Ananda or Eichstaedt, either separately or in combination, mention anything regarding receiving a request to access the web site that includes an identifier corresponding to a *computer user*, searching for a matching identifier and identifying the first identifier as a distinct computer user if the searching did not result in a match.

In further regard to claim 20, the Examiner's combination of Shelton, Holden, Ananda and Eichstaedt fails to teach or suggest receiving a request from a first computer user to access the web site, wherein the request comprises an Internet address and a time value corresponding to said first computer user accessing said web site, and determining first computer user is a distinct user by comparing the time value and the Internet address with a database of time value information and Internet address information compiled from previous web site accesses, as presented in claim 20. The Examiner rejects claim 20 for the same reasons as claim 1, discussed above. **The Examiner has improperly ignored differences between claims 1 and 20.** For example, claim 20 recites receiving a request from a computer user to access a web site that comprises an Internet address and a time value. The Examiner has failed to cite any portion of the prior art or to provide any arguments regarding these limitations of claim 20.

Similarly, **the Examiner has improperly ignored differences between claims 1 and 30.** The Examiner rejects claim 30 for the same reasons as claim 1. However, claim 30 recites determining whether the computer user is counted as a web hit by comparing said time value and said Internet address with a database of time value information and Internet address information compiled from previous web site accesses. Eichstaedt teaches comparing *a number of requests made within a time period* to a predefined maximum number, but none of the cited art teaches anything regarding comparing a time value and an Internet address with a database of time value information and Internet address information compiled *from previous web site accesses* to determine whether a computer user is counted as a web hit.

As discussed above, the Examiner has failed to provide a prima facie rejection of Applicant's independent claims. The Examiner's combination of cited art does not result in Applicant's invention as claimed. Additionally, the Examiner has improperly combined the cited art without providing proper motivation for such a combination.

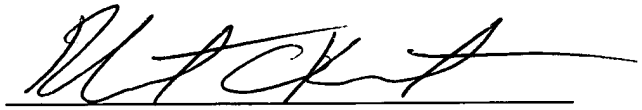
In light of the foregoing remarks, Appellants submit the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Appellants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5596-00200/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☒ Notice of Appeal

Respectfully submitted,



Robert C. Kowert
Reg. No. 39,255
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

Date: April 26, 2006